



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,490	01/15/2004	Georg Burkhart	512425-2098	5973

7590 02/14/2006

William F. Lawrence, Esq.
c/o FROMMER LAWRENCE & HAUG LLP
745 Fifth Avenue
New York, NY 10151

EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
----------	--------------

1712

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

5

Office Action Summary	Application No.	Applicant(s)	
	10/758,490	BURKHART ET AL.	
	Examiner	Art Unit	
	Margaret G. Moore	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 6, 8 to 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 to 6, 8, 10 to 13 and 15 is/are allowed.
- 6) ☒ Claim(s) 9, 14, 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1712

1. Applicants' amendment, accompanied by the documentation regarding Amberlyst 15, has overcome most of the prior art rejections. As noted below, however, many issues remain in this application.

2. Initially the Examiner notes that applicants have not complied with, or even addressed, the requirement for information noted in paragraphs 7 and 8 of the previous office action. As noted therein, this information is necessary for the consideration of both prior art rejections and rejections under 35 USC 112. This requirement is maintained. The Examiner stresses that this application cannot pass to issue until this requirement is met.

3. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants' mere assertion that "it is well known within the art that physical characteristics are for room temperature unless otherwise indicated" is not supported by any documentation. This rejection is maintained.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 14 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Litteral.

Applicants have distinguished the claimed process from that in Litteral but they have not established a difference between the organopolysiloxane in claim 14 and that in the prior art. As a formality, note that claim 14 uses the term "*obtainable*" which means that the organopolysiloxane is *able* to be obtained by the process of claim 1, but not necessarily. While this is a technical difference easily overcome by amending the claim to use the term "obtained" it is still a point that must be addressed.

Assuming that the organopolysiloxane in claim 14 is obtained by the method of claim 1, it is the Examiner's position that applicants have not adequately demonstrated that the organopolysiloxane claimed is different from that in the prior art.

While the specification includes some comparative examples these are in no way commensurate in scope with the claimed process such that one can conclude that the organopolysiloxanes prepared by the breadth of claim 1 are different from those prepared by the prior art method. Initially, please note that Litteral is not limited to methods using Amberlyst 15, the only exemplified catalyst in the comparative examples. In addition the teachings in Litteral demonstrate that process conditions can be varied to obtain different products. See for instance the bottom of column 4, which notes different catalysts and how pore volumes affect the final product. The top of column 5 teaches that residence time affects the final product.

On the other hand, the examples in the specification use only one catalyst within the breadth of claim 1 and this does not adequately represent any criticality for the entire breadth of catalysts included in claim 1. The method of claim 1 is much broader than the method shown in the specification.

Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Please note MPEP 2113, which addresses the appropriateness of a rejection under 35 USC 102/103 for product by process claims.

Art Unit: 1712

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burkhardt et al. in view of Litteral.

In the previous office action the Examiner read this claim as if it were a dependent claim. In fact, it is an independent claim. The previous rejection is maintained. While perhaps an anticipation rejection could have been made, since "the organopolysiloxane" could be any organopolysiloxane, an obviousness rejection is still proper.

Applicants' response has not addressed this rejection. Similar to the rejection noted above, there is nothing that indicates that the organopolysiloxane added in the method of claim 16 is different from the organopolysiloxane of Burkhardt or Litteral. As such this rejection is maintained.

8. The Examiner notes that claim 15 includes the process steps of claim 1 rather than an organopolysiloxane prepared by the process of claim 1. Because of this claim 15 is neither taught nor suggested by the prior art.

9. Claims 1 to 6, 8, 10 to 13 and 15 are allowed. The prior art fails to adequately suggest the use of a cation exchange resin meeting this mean pore diameter, as noted in applicants' reply.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1712

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
2/8/06